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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,657	11/07/2001	George Morrison	ARTM 1011-4 US	9884

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O'MELVENY & MEYERS  
114 PACIFICA, SUITE 100  
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EXAMINER
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ROLLINS, ROSILAND STACIE

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/045,657	<b>Applicant(s)</b> MORRISON ET AL.	
	<b>Examiner</b> Rosiland S. Rollins	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
        1. ☐ Certified copies of the priority documents have been received.  
        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
    \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
    a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5/9:3/3</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 47-51, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. (US 6514248) in view of Eggers (US 5611798).**

Eggers et al. disclose a method for creating a tissue section within surrounding tissue comprising positioning a distal end of a catheter assembly at a target location within a patient, moving an elongate tissue separator element wherein the separator element cuts tissue as it is extended outwardly and rotating the separator element about an axis to separate a tissue section from surrounding tissue. Eggers et al. teach all of the limitations of the claims except initiating an electrosurgical arc. Eggers teaches that it is old and well known in the art at the time the invention was made to initiate a spark during an electrosurgical cutting procedure to cause the tissue to be coagulated after it is cut. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to initiate a spark during the Eggers et al. procedure so that the tissue being treated could be coagulated after it has been cut.

**Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. '248 further in view of Burbank et al. (US 6540693).**

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Eggers et al. teach all of the limitations of the claims except moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition. Burbank et al. disclose a similar procedure and teach that it is old and well known in the art to moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition as illustrated in figure 15, to secure the device to the tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide and move a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition during the Eggers et al. procedure as taught by Burbank et al. to secure the device to the tissue.

**Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. '248 further in view of Wilk et al. (US 5417697).**

Eggers et al. teach all of the limitations of the claims except surrounding the separated tissue section with a tubular braided element. Wilk et al. disclose a similar procedure and teach that it is old and well known in the art to surround the separated tissue section with a tubular braided element (see figures 8a-c and col. 8 lines 49+) to capture and remove tissue following separation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to surround the separated tissue section with a tubular braided element during the Eggers et al. procedure as taught by Wilk et al. to capture and remove tissue following separation.

**Claims 56-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. '248 further in view of Burbank et al. '693 and Wilk et al. '697.**

Eggers et al. teach all of the limitations of the claims except moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition and surrounding the separated tissue section with a tubular braided element.

Burbank et al. disclose a similar procedure and teach that it is old and well known in the art to moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition as illustrated in figure 15, to secure the device to the tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide and move a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition during the Eggers et al. procedure as taught by Burbank et al. to secure the device to the tissue.

Wilk et al. disclose a similar procedure and teach that it is old and well known in the art to surround the separated tissue section with a tubular braided element (see figures 8a-c and col. 8 lines 49+) to capture and remove tissue following separation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to surround the separated tissue section with a tubular braided element during the Eggers et al. procedure as taught by Wilk et al. to capture and remove tissue following separation.

### ***Response to Arguments***

Applicant's arguments with respect to claims 47-51 and 62 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the membranous barrier shroud of Eggers et al. moves circumferentially, not longitudinally. Examiner would like to first point out that the embodiment of Eggers et al. that discloses the membranous barrier shroud was not relied upon in the rejection. Furthermore, Applicant's assessment that the shroud does not move longitudinally is inaccurate since the shroud does in fact move longitudinally while being deployed. Also, the purpose of the shroud is to retard neovascularization, which is not the same reason, used in combining Eggers et al. with Wilk et al. The Wilk et al. reference was used by the Examiner for the teaching of a tubular element used to remove tissue following separation, not to simply provide a barrier to prevent neovascularization. This line of reasoning clearly establishes a motivation for combining Eggers et al. with Wilk et al. Moreover, Applicant argues that Wilk et al. is from an unrelated field, since Wilk et al. is reasonably pertinent to the particular problem with which the applicant is concerned - removing tissue from the body, Wilk et al. is analogous art

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Rosiland S Rollins*  
Rosiland S Rollins  
Primary Examiner  
Art Unit 3739